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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/738,127	12/15/2000	Larry B. Li	50944.9900	9821
7590	08/24/2004		EXAMINER	
SCOTT A. HORSTEMEYER			DEMAKIS, JAMES A	
THOMAS, KAYDEN, HORSTEMEYER & RISLEYY, L.L.P.			ART UNIT	PAPER NUMBER
100 GALLERIA PARKWAY				
SUITE 1750			2836	
ATLANTA, GA 30339			DATE MAILED: 08/24/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/738,127	LI, LARRY B.	
	<b>Examiner</b>	<b>Art Unit</b>	
	James A Demakis	2836	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 29 July 2004.  
 2a) This action is **FINAL**.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-18 and 20-30 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) 1-12 is/are allowed.  
 6) Claim(s) 13-15, 20 and 22-24 is/are rejected.  
 7) Claim(s) 16-18, 21, 25-30 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 15 December 2000 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the fourth paragraph of 35 U.S.C. 112:

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

2. Claim 23 is rejected under 35 U.S.C. 112, fourth paragraph, as failing to further limit.

Claim 23 does not further limit, in that it is the same as claim 21.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 13-15, 20,22,24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ravanelli et al (US PN 5789785) and in view of Colclaser et al (US PN 6327125).

Regarding claims 13-15,20,22,24:

Ravanelli et al disclose in Figure 2 an ESD protection circuit using a bipolar NPN transistor Q1 in reverse mode from a pad T1 to a ground T2 for biCMOS Ics. It does not disclose that the protected circuit operates at a high frequency, above 1 GHz.

Colclaser et al disclose that biCMOS Ics require ESD protection and that they operate currently in the 1-2 GHz range and next generation RF circuits are expected to operate above 10 GHz, see 5:20-25. Also, the protection circuit can be implemented in any of the standard processes, such as bipolar, CMOS, or biCMOS; see 5:40-43.

It would have been obvious to one having ordinary skill in the art at the time of the invention to have modified Ravanelli et al with the teaching of Colclaser et al and minimize capacitive loading on the protected circuit and extend performance at higher frequencies.

***Allowable Subject Matter***

5. Claims 1-12 are allowed.
6. The following is an examiner's statement of reasons for allowance:

The above claims are allowed because the prior art of record fails to disclose or suggest a reverse mode transistor configured to protect a circuit between a pad and ground; and having a capacitance between the base and the emitter of about ten times less than the parasitic capacitance between the collector and the substrate..

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

7. Claims 16-18,21,25-30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

8. Applicant's arguments filed 7/29/2004 have been fully considered but they are not persuasive.

The Colclaser et al reference is relied upon as one disclosure that ESD protection schemes and techniques, which include active devices, are known to operate effectively in the 1-2 GHz range and may impose too high of a capacitive load for RF circuits operating above 10 GHz; which implies adequate operation up to this frequency.

9. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both references Ravanelli et al and Colclaser et al disclose ESD protection circuits or devices using active devices to short any ESD energy to ground. Colclaser et al teaches that these protection schemes can limit the intended high frequency performance of the protected circuit due to the

capacitive load presented from the active protection devices and suggests that the limits of effective high frequency performance is to 10 GHz.

***Conclusion***

**10. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

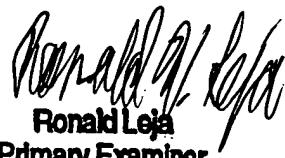
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A Demakis whose telephone number is 571.272.2050. The examiner can normally be reached on 7:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Sircus can be reached on 571.272.2800 ext. 36. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James A. Demakis

  
Ronald Leja  
Primary Examiner

  
8/22/04